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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,550	03/20/2001	Hideyuki Hirano	1405.1039	9079
21171	7590	05/20/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			FIELDS, COURTNEY D	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,550

Applicant(s)

HIRANO ET AL.

Examiner

Courtney D. Fields

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claim 21 has been cancelled.
2. Claims 1,3-4 and 9-19 have been amended.
3. Changes made to the specification have been accepted by the Examiner.

Response to Arguments

1. Applicant's arguments have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Watanabe (US Pub No. 2002/0069359).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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2. Claims 1,3-5,10-14, and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe (US Pub No. 2002/0069359).

Regarding claim 1, Watanabe teaches a data administration method, which comprises:

preparing a real data section by encrypting digital content to be distributed (page 2, Sections 0039-0040)

preparing a summary data section provided with symbol information symbol-converted for visual or auditory recognition of attributes of the digital content (page 3, Section 0041)

preparing a consent-information-added summary data section in which consent information containing information on a content key used as an encryption key in encrypting the digital content is embedded in the summary data section (page 3, Section 0042)

preparing composite' data in which the real data section and the consent-information-added summary data section are composited, and distributing the composite data (page 3, Sections 0043-0048).

Regarding claim 3, Watanabe teach everything as claimed above (claim 1), in addition Watanabe teaches preparing an annex data section in which use restriction information for restricting use of the digital content is encrypted (page 2, Section 0029).

Regarding claim 4, Watanabe teach the method as in claim 3, in addition Watanabe teaches use restriction information is embedding logic for embedding the

consent information as the electronic watermark in the summary data section (page 2, Sections 0031-0038)

Regarding claim 5, Watanabe teaches the method as in claim 3, in addition Watanabe teaches use restriction information is based on a use term during which, or on a use count up to which, the digital content is usable (page 2, Sections 0021-0027).

Regarding claim 10, Watanabe teaches a data administration method, which comprises:

separating an annex data section from composite data distributed as a composite of a real data section in which digital content to be distributed is encrypted, in a summary data section enabling visual or auditory recognition of substance of the digital content, a consent-information-added summary data section in which consent information containing information on a content key used as an encryption key in encrypting the digital content is embedded, and an annex data section in which use restriction information for restricting use of the digital content is encrypted;

decrypting the annex data section and extracting the use restriction information',
extracting the consent information embedded in the consent-information-added summary data section based on the use restriction information;

obtaining from the consent information a content key for decrypting the digital content, and

using the content key, decrypting the real data section into its original digital content to allow use by users (page 3, Sections 0050-0052, page 4, Sections 0053-0058).

Regarding claim 11, Watanabe in combination teach everything as in claim 1, in addition Watanabe teaches embedding in the summary data section as a visually or auditorily unrecognizable electronic watermark a hash value generated from the real data section using a hash function (page 3, Sections 0043-0044).

Regarding claim 12, Watanabe in combination teach everything as in claim 11 , in addition Watanabe teaches decrypting the real data section into digital content for sending out, by line-connecting to a predetermined contact destination, content information from the digital content that is decrypted (page 4, Sections 0059-0060), and therein

embedding in the summary data section as a visually or auditorily unrecognizable electronic watermark the content information from the digital consent that is decrypted and information on the predetermined contact destination (page 4, Section 0061).

Regarding claim 13, Watanabe teach everything as in claim 11, in addition Watanabe teaches preparing composite data in which the real data section and the consent-information-added summary data section are composited and therein retaining within the composite data record-location composite, information from a server in which the digital content is registered (page 4, Section 0062).

Regarding claim 14, Watanabe teach everything as in claim 13, in addition Watanabe teaches the record-location information from the server in which the digital content is registered is embedded in the summary data section as a visually or auditorily unrecognizable electronic watermark (page 4, Section 0063).

Regarding claim 17, Watanabe teach everything as in claim 11, in addition Watanabe teaches identifying information specific to a recording medium for recording the digital content (page 4, Section 0064).

Regarding claim 18, Watanabe teach everything as in claim 11, in addition Watanabe teaches a control code allowing a given operation on an information device on an information device for reproducing the digital content (page 4, Section 0058).

Regarding claim 19, Watanabe teach everything as in claim 11, in addition Watanabe teaches privileges information for the digital content including copyright information is embedded within the digital content as an electronic watermark (page 5, Sections 0065-0066).

Regarding claim 20, Watanabe teach the method of claim 19, in addition Watanabe teaches the morphology and code level of the electronic watermark embedded in the digital content are determined based on a data quality level and a security level required by the digital content (page 3, Section 0041).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Peinado et al. (US Patent No. 6,775,655).

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Regarding claim 2, Watanabe teach the data administration method as in claim 1, but does not teach said header data section is made by compositing into one image data item more than one image-symbol data item symbol-converted for visually recognizing attributes corresponding respectively to a plurality of digital content items. Peinado et al. teaches header data section is made by compositing into one image data item more than one image-symbol data item symbol-converted for visually recognizing attributes corresponding respectively to a plurality of digital content items (col.13 line 61 thru col.14 line 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Watanabe's system of generating digital contents with Peinado et al.'s system for rendering digital content in an encrypted rights protection form in order to provide secure method for distributing digital content that will allow the digital content to be only rendered as specified by the content provider (Peinado et al. col.2 lines 20-41).

5. Claims 6-9 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Pfitzmann et al. (Asymmetric Fingerprinting). Watanabe teach the data administration method as in claim 3, but does not teach personal information of a user such as a password, identifying information or biometric information.

Regarding claim 6, Pfitzmann et al. teaches the use restriction information is encrypted with, as an encryption key, personal information on a user of the digital content (page 86 and page 89).

Regarding claim 7, Pfitzmann et al. teaches the encryption key when encrypting the use restriction information is a password preset by the user (page 87).

Regarding claim 8, Pfitzmann et al. teach the method as in claim 6, in addition Pfitzmann et al. teaches the encryption key when encrypting the use restriction information is identifying information specific to a recording medium in which the composite data is recorded (page 84-85).

Regarding claim 9, Pfitzmann et al. teaches the encryption key when encrypting the use restriction information is biometric information on the user (page 89).

Regarding claim 15, Pfitzmann et al. teaches preparing composite data in which the real data section and the consent-information-added summary data section are composited, and therein retaining within the composite data biometric template, information generated based on biometric information on a user of the digital content (page 87-88).

Regarding claim 16, Pfitzmann et al. teaches the biometric template information is embedded in the summary data section as a visually or auditorily unrecognizable electronic watermark (page 90).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Watanabe's system of generating digital contents with Pfitzmann et al.'s asymmetric fingerprinting system for restricting illegal copying of digital content providing a secure method for distributing digital content that will allow the merchant to identify the user by using a fingerprinting scheme (Pfitzmann et al., page 84, Abstract).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 571-272-3871. The examiner can normally be reached on Mon - Thurs. 6:00 - 4:00 pm; off every Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


cdf

May 12, 2005


MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137